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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,989	09/26/2001	Roland N. Walker	12160.2	2969
21999	7590	12/30/2004	EXAMINER	
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			BAHTA, ABRAHAM	
			ART UNIT	PAPER NUMBER
			1775	
DATE MAILED: 12/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/964,989

Applicant(s)

WALKER, ROLAND N.

Examiner

Abraham Bahta

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/20/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 16-20, 25 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 11-15, 21-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

Claims 1-34 are pending in this application. Claims 1-10 and 16-20 are withdrawn from further consideration as being drawn to a non-elected invention.

Further, the amendment filed 03/22/04 indicates that claims 25 and 31-34 (previously examined) are now withdrawn.

### ***Claim Rejections - 35 USC § 112***

Claims 11 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On page 7, line 21 through page 8, line 2 the specification recites the image may be provided onto an organic product in variety of manners, for example, the images may be printed, painted, sprayed, copied, transferred, etched, embossed, engraved, scratched, stamped, cut, imprinted, scored, carved or otherwise marked into at least a portion of an organic product; however, claims 11 and 24 recite each of the group of flowers is free from etching and laser exposure and pressure. The applicant is reminded that a negative limitation recited in the present claims, which did not appear in the specification as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 US 112, (*In re Anderson*, 471 F. 2d. 1237, 176 USPQ 331 (CCPA 1973)). No clear support <sup>is found</sup> for this negative limitation.

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Claims 11 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 24 recite each of the group of flowers is free from etching, and laser exposure and pressure; however, the applicant states (page 10, line 3 through page 12, line 23) that the image may be pressed on the organic product by the pad printing device. It is not clear what applicant intends to claim with the introduction of this negative limitation. Does applicant intend to limit the article to one that is not etched or laser treated or have pressure applied? Clarification is requested.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15 and 21-24 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (USP 6,172,328) or Skonecki (USP 5,305,550).

Jones teaches an organic product such as a leaf/ flower petals which may be in a natural configuration (see Fig. 1 and col. 3, lines 43-45) in which the organic product may be marked/etched with a device/laser/galvanometer. The marking may be a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27.

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Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. See col. 3, lines 38-44. Therefore, it is the position of the Examiner that the flower is in an undamaged form.

Jones does not require pad-printed image; however, Jones is concerned with the ability of the leaf to photosynthesize and respire, even when the design is provided on the surface of the flower. It is clear that damage may be considered loss of the ability to photosynthesize and respire. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a pad-printed image on the organic product so that the organic product/leaf may not be damaged and continue to photosynthesize and respire.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38.

Skonecki does not require identical images on a number of flowers; however, Jones and Skonecki teach the concept of providing an image, drawing or personalized message on the flower petal or rose. It is well known to use a stamp to provide identical images on materials and it would have been obvious to the skilled artisan to use a stamp or pad if a series of identical images is desired. The limitation such that the image is "pad-printed" has been considered; however, the fact remains that both references teach the concept of providing a mark or inscription on an organic product such as a flower. Therefore, it would have been obvious to one of ordinary skill in the art

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at the time the invention was made to have utilized the desired printing device including pad-printing, since it has been held that providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding claims 15 and 27, patentability of product-by-process claims is based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Regarding claims 14, 26 and 28-30, Jones teaches the ornament design or marking formed on the flower/petal may be a message, greeting, expression, identification, information, communication, inscription, advertisement, bar code, inventory marking price information or business message. See col. 3, lines 21-38. In addition, Skonecki teaches the inscription may be personalized message such as the word "congratulations". See Skonecki fig. 1.

### ***Response to applicant's arguments***

The applicant argues that Skonecki does not teach a group of flowers each having placed thereon a repeatable overlaid identical pad-printed image or in that each of the flowers in the group of flowers is in an undamaged natural configuration and that since Skonecki's process is performed by a human, there is a chance that the Skonecki process can result in more than minimal pressure being applied thereby damaging the petal. The Examiner contends that the claims of the instantly claimed invention are drawn to an article and not to a process. Further, the Examiner contends that although

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Skonecki uses a pen to write on the surface of the petal, a fine line of paint is applied which dries almost instantly upon contact with the surface of the petal and as a result, no smearing, smudging or other unwanted marks are left on the petal surface. See Skonecki col. 2, lines 19-24. The applicant contends that the flower of the present claimed invention is "undamaged" whereas the rose of Skonecki '550 is indented, causing surface cellular damage and faster withering. The Examiner disagrees. Skonecki at col. 2, lines 19-24 teaches when the Pilot pen is used to write on the surface of the petal, a fine line of paint is applied which dries almost instantly upon contact with the surface of the petal and that no smearing, smudging or other unwanted marks are left on the petal surface. See Skonecki col. 2, lines 22-28. Regarding the limitation that the flowers comprise a repeatable, identical pad-printed image, the Examiner contends that providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. Further, the applicant argues that Skonecki does not teach a process for transferring an image onto an organic product by rolling the surface of the pad that includes the negative image onto the surface of an organic product. The Examiner contends that the claims of the subject application (elected claims) do not recite the limitation that the image may be transferred onto an organic product by rolling the surface of the pad that includes an image. Regarding claim 24, the applicant contends that the claim includes limitations for a flower free from etching, laser or pressure and argues Skonecki does not teach a method that produces a flower completely free from damage; however, Skonecki teaches that the paint is applied with minimal pressure to prevent damage.

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Therefore Skonecki clearly teaches that one objective is to prevent damage to the flower. A "chance" that damage may still occur is not persuasive to overcome the clear teaching of Skonecki. Applicant on page 15 of the ~~specification~~<sup>arguments</sup> admits that pressure is applied with the pad-printing techniques. It is not clear what amount of pressure would qualify as imparting damage.

With respect to Jones the applicant argues that the reference does not teach a group of flowers each having placed thereon an overlaid identical pad-printed image wherein each of the group of flowers is in a natural undamaged configuration and that instead, Jones teaches a group of flower that have etched, cut or altered surfaces which have been disrupted on their surfaces or have been cut by the laser beam. The Examiner contends that the fact remains that Jones teaches the concept of providing an organic product such as a flower with a marking such as a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27. Further, the applicant argues that the reference teaches methods for etching, cutting the surface of a flower, plant cut foliage and that the process of Jones does not teach overlaying an image onto a group of flowers in a natural undamaged configuration. The Examiner disagrees. Jones teaches the leaves may be provided with a design by inserting an opaque metal stencil machined with the desired design and focusing optics between a stationary laser beam and foliage and that the leaves may be used in floral arrangement or potted plant arrangements to convey a greeting such as "Happy valentines Day". Jones teaches the designs may be provided using stencils. See col. 1, lines 54-65 and col. 4, lines 26-27.



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Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. See col. 3, lines 38-44.

With regard to applicant's argument that none of the reference teach a group of flowers free from etching, and laser exposure and pressure, the Examiner contends that negative limitation recited in the claims of the subject application do not appear in the specification as filed and in fact introduce new concepts and violate the description requirements of the first paragraph of 35 USC 112.

#### ***Commercial success and Declaration***

In response to applicants commercial success and declaration the Examiner contends that to establish commercial success, applicant bears the burden of showing that such success is derived from the claimed invention and to have occurred "in a market place where the consumer is free to choose on the basis of objective principles". It must be shown "such success is not the result of heavy promoting or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention". See MPEP 716.03(b). Applicant also bears the burden of supporting the contention of nonobviousness by establishing a nexus between the claimed invention and evidence of commercial success. The evidence provided is not commensurate in scope with the claims.

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Any inquiry concerning this communication should be directed to Abraham Bahta whose telephone number is (571) 272-1532. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Bahta

12/14/04



JENNIFER MCNEIL  
PRIMARY EXAMINER